

Application No. 09/940,565
Applicant: Dirk Lenz
Amendment in Response to Office Action dated July 28, 2003

REMARKS

Applicant respectfully requests reconsideration and allowance of this application in view of the amendments above and the following comments.

Claims 1, 3 – 8, and 10 – 13 are pending. Claims 2 and 9 has been canceled. Subject matter found in the "especially" clause of claim 7 is now in new claim 13. Amendments have been made to claims 1 and 8 in response to the rejections under 35 U.S.C. 102. Support for the amendments is found in the originally filed claims 2 and 9 and in the Example in the specification starting at page 7. Amendments have been made to claim 7 to place the claim in better patent practice format in the event claim 7 is rejoined with the product claims. Claims 7, 11 and 12 have been withdrawn. The changes that have been made to these claims using strikethrough and underlining are presented above. It is believed that no new matter has been added.

Elections/Restrictions

Applicant hereby affirms the election with traverse the invention of Group I, comprising claims 1-6, 8-10. Regarding the traversal, the traversal is on the grounds that Groups II and III should be examined together with Group I. In this regard, Applicant would call the Examiner's attention to the Commissioner's Notice published in the Official Gazette on March 26, 1996, at 1184 OG 86. According to that notice:

"[A]pplicant may be called upon under 35 U.S.C. § 121 to elect claims to either

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the product or the process. The claims to the non-elected invention will be withdrawn from further consideration. However, in the case of an elected product claim, rejoinder will be permitted when a product claim is found allowable and the withdrawn process claim depends from and otherwise includes all the limitations of an allowed product claim."

See also MPEP §821.04. Applicant presumes that the Examiner is proceeding in accordance with this notice, and that Groups II and III will be rejoined and examined in the event that Group I is found to be allowable. If not, then Applicant would appreciate an explanation from the Examiner of why this notice is not applicable.

Rejections under 35 U.S.C. 102

The Examiner rejected claims 1 and 5 under 35 U.S.C. 102(e) as being anticipated by Gessner et al. (U.S. Patent No. 5,997,989). The Examiner found Gessner to teach a wound dressing comprising an outer spunbond layer and a staple-fiber nonwoven. In response, Applicant has incorporated the subject matter contained in canceled claim 2, which was not rejected in view of the cited prior art under this section. Accordingly, because Gessner does not teach "a wound dressing and/or compress comprising a skin facing layer of a spunbond comprising polypropylene and at least one layer of a staple fiber nonwoven comprising polypropylene disposed on said spunbond, wherein the layers are nondetachably bonded together by ultrasonic welding", Applicant submits the claims are not anticipated.

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In view of the foregoing, Applicant submits that the Examiner would be fully justified to reconsider and to withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is, therefore, earnestly solicited.

Rejections under 35 U.S.C. 103

The Examiner rejected claims 2-4, 6 and 8-10 under 35 U.S.C. 103(a) as being obvious in view of Gessner et al. The teaching of Gessner was described above. The Examiner concedes Gessner does not teach: (1) the composition of staple fibers, (2) the basis weight of the fabrics, (3) five plies of fabric, (4) the addition of aramid, (5) the film is perforated, and (6) the film is made of polypropylene. The Examiner found all of the above instantly claimed elements would have been obvious in view of the general teaching of Gessner. In response to the allegations that (1) to (6) above would have been obvious, Applicant points out that "that which is within the capabilities of one skilled in the art is not synonymous with obviousness". *Ex parte Levengood*, 28 USPQ2d 1300, 1302 (Fed. Cir. 1993). There must be some suggestion or motivation, either in the reference of knowledge generally available to a person skilled in the art to modify the teaching of the reference. See MPEP §2143. Accordingly, there is nothing in Gessner to suggest the limitations found in the claims that would render them obvious.

Further on this point, to establish a *prima facie* case of obviousness the Examiner must cite prior art references teaching all the claim limitations or take official notice of these claim limitations. Applicant points out that official notice "unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be

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common knowledge in the art are capable of instant and unquestionable demonstration as being well-known." MPEP §2144.03. The fact at issue in the instant case does not fall in this category. It is not a fact "capable of instant and unquestionable demonstration as being well-known" that a person skilled in the art would have used polypropylene in both the spunbond and nonwoven layers. Rather, the Examiner has simply concluded this fact and as a result, that the claims are allegedly obvious, and as such the Examiner's rationale falls into the category of the "obvious to try" standard which is presumptively improper. See MPEP §2145 ("Obvious to Try Rationale"). The Examiner's assertion that a person skilled in the art would have found it "obvious...to utilize polypropylene" without the citation of documentary evidence and support, is nothing more than a statement that it would have been "obvious to try" polypropylene in the staple fibers and spunbond. As the Federal Circuit noted in *In re Grabiak*, generalization of this type should be avoided. See *In re Grabiak*, 226 USPQ 870 (Fed. Cir. 1985) ("[G]eneralization should be avoided insofar as specific chemical structures are alleged to be *prima facie* obvious one from the other").

Even if the Examiner's allegation of Gessner teaching an outer spunbond layer and a staple fiber nonwoven were correct - which Applicant does not concede - a person skilled in the art would not have been led to the present invention, because there is nothing in Gessner that suggests that both the spunbond and the staple fiber nonwoven to comprise polypropylene, as the Examiner already concedes. Accordingly, the claims are not rendered obvious by Gessner, and thus limitations found in the dependent claims cannot be overcome by the allegations of the Examiner.

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In view of the foregoing, Applicant submits that the Examiner would be fully justified to reconsider and to withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is, therefore, earnestly solicited.

Conclusion

Applicant believes that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicant also believes that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

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Early and favorable action is earnestly solicited.

Respectfully submitted,

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.111 (11 pages total) are being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: January 26, 2003

By 
David D. Kim